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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,642	12/05/2005	David B Harder	758.1416USWO	7536
23552 7590 03/10/2009 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
GONZALEZ, MADELINE				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
03/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,642

**Applicant(s)**

HARDER ET AL.

**Examiner**

MADELINE GONZALEZ

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30 and 33-36 is/are allowed.
- 6) ☒ Claim(s) 19-29, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

In response to applicant's amendment dated December 3, 2008

### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21, 23, 26-29, 31 and 32 are finally rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krull (U.S. 5,490,930).

With respect to **claims 19 and 32**, Krull discloses a filter 10, as shown in Fig. 2, having:

- a housing 11 having a wall 12 defining a closed end 13, an open end, an interior volume, and an inwardly extending ledge 30, 31, as shown in Fig. 5;
  - the housing 11 including a threaded region 19 adjacent to the open end;

- the inwardly extending ledge 30, 31, being circumferential and extending completely along an internal surface of the housing wall 12;
    - the inwardly extending ledge 30, 31, being located axially between the closed end and the threaded region 19;
- a filter cartridge 20 oriented within said interior volume of said housing 11; said filter cartridge 20 including a tubular construction of filter media 24 defining an open filter interior;
  - said tubular construction of filter media 24 having a first end;
  - said filter cartridge 20 includes an end cap 21 secured to said first end of said tubular construction of filter media 24; said end cap 21 defining an aperture in fluid communication with said open filter interior;
- a projection arrangement 51, as shown in Fig. 7, constructed and arranged to space said filter cartridge 20 from said housing wall 12 to define a fluid flowpath between said filter cartridge 20 and said housing wall 12;
  - the projection arrangement 51 includes a base and a sidewall;
  - said projection arrangement 51 including at least one projection 57 in extension from at least one of said base and said sidewall, as shown in Fig. 7;
  - the projection arrangement 51 engaging the inwardly extending ledge to space said filter cartridge 59 from said housing wall 12 to define a fluid flowpath between said filter cartridge 59 and said housing wall 12, as shown in Fig. 5;

- with respect to **claim 32**: Krull teaches a mounting adaptor (head) having a fluid flow inlet port and fluid flow outlet port, and the filter is releasably secured to said filter head (see col. 2, lines 46-50).

With respect to the inwardly extending ledge being located axially between the closed end and the threaded region: The ledge 30, 31, disclosed by Krull, extends axially, and, in terms of fluid flow, is between the threaded region 19 and the closed end. Physically, it appears that the ledge 30, 31, is in line with the treaded region 19, as shown in Fig. 5. However, to physically positioned the ledge disclosed by Krull between the threaded region and the closed end would have been obvious to one of ordinary skill in the art at the time the invention was made since that would be considered a change in shape and the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669,149 USPQ 47 (CCPA 1966)).

With respect to **claim 32**, in the alternative, Krull discloses all the claimed limitations stated above in claim 19, including a filter head 16 having a fluid flow inlet port 53 and fluid flow outlet port 19, as shown in Fig. 5, but **lacks** filter arrangement being releasably secured to said filter head. It would have been obvious to provide the filter arrangement 10 releasably secured to the filter head 16 since the courts have held that if for any reason it is desirable to do so, then it would be obvious to make something separable for that purpose (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)).

With respect to **claim 20**, Krull discloses wherein said projection arrangement 51 includes a plurality of projections 57, as shown in Fig. 7.

With respect to **claim 21**, Krull discloses wherein each of said projections 57 extends axially to engage said housing 11, as shown in Fig. 5.

With respect to **claim 23**, Krull discloses wherein said base and said sidewall are part of said end cap 51, as shown in Fig. 5.

With respect to **claim 26**, Krull discloses wherein each of said projections 57 includes a free end, as shown in Fig. 7; each free end of said projections 57 engaging the inwardly extending ledge, as shown in Fig. 5.

With respect to **claim 27**, Krull discloses wherein each of said projections 57 extends radially to engage the inwardly extending ledge, as shown in Fig. 7 (see col. 8, lines 16-20).

With respect to **claim 28**, Krull discloses wherein each of said projections 57 extends radially from said base of said end cap 51, as shown in Fig. 5.

With respect to **claim 29**, Krull discloses wherein said sidewall includes a media-containing portion 58 that forms a continuous wall around said filter media 59; said

media-containing portion 58 extending from said base; and said projections being generally orthogonal relative to said media-containing portion, as shown in Fig. 5.

With respect to **claim 31**, Krull discloses wherein said filter media 59 includes pleated media and a second end opposite of said first end; said end cap 51 is a first end cap; and said filter cartridge 20 further includes: a second end cap 22 secured to said second end of said filter media 59; said second end cap 22 being closed; and an inner tubular liner 23 circumscribed by said pleated media; said inner tubular liner 23 extending between said first end cap 51 and said second end cap 22, as shown in Fig. 2.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22, 24 and 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Krull (U.S. 5,490,930).

**Claim 22** adds the limitation of wherein said base and said sidewall are part of a plate that is a separate piece from said end cap.

Krull **lacks** the limitations of claim 22.

It would have been obvious to make the end cap separable from a plate having the base and the sidewall since the courts have held that if for any reason it is desirable to do so, then it would be obvious to make something separable for that purpose (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)).

With respect to **claim 24**, Krull discloses wherein each of said projections 57 extends axially from said sidewall of said end cap 51, as shown in Fig. 7.

With respect to **claim 25**, Krull discloses wherein said sidewall includes a media-containing portion 58 that forms a continuous wall around said filter media 59; said media-containing portion 58 extending from said base and having an end; each of said projections 57 being in extension from said end of said media-containing portion 58, as shown in Fig. 5.

#### ***Allowable Subject Matter***

Claims 30 and 33-36 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Claim 33 is allowed because the prior art of record does not show or suggest a method of making a filter including the step of snapping the projection over a radial protrusion in the housing, in combination with the remaining limitations in the claim.

Claims 34-36 are allowed due to their dependency on claim 33.



### ***Response to Arguments***

Applicant's arguments filed on December 3, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Krull fails to disclose an inwardly extending ledge in a housing located axially between a closed end and a threaded region of the housing: Krull teaches an inwardly extending ledge 30, 31, that is, in terms of fluid flow, extending axially between the closed end of the housing and the threaded region 33. To physically position the ledge between the closed end and the threaded region would have been obvious since one of ordinary skill can change the shape of the housing, as stated in the rejection above. Furthermore, it appears that the difference between applicant's embodiment in Fig. 19 and Krull's embodiment in Fig. 5, is that the position of the seal and the threaded region are reversed. To change the position of the seal and threaded region disclosed by Krull to the position shown by applicant in Fig. 19 would have been obvious since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez  
Patent Examiner  
March 9, 2009

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797